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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,712	06/26/2003	Akihiko Suyama	393032038600	6937
7590 David L. Fehrman Morrison & Foerster LLP 35th Floor 555 W. 5th Street Los Angeles, CA 90013		06/07/2007	EXAMINER PHAM, VAN T	
			ART UNIT 2627	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/608,712

**Applicant(s)**

SUYAMA, AKIHIKO

**Examiner**

VAN T. PHAM

**Art Unit**

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-9, 11-18, 20, 21, 23-52 is/are pending in the application.
- 4a) Of the above claim(s) 1, 10, 19 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 3, 5-8, 11, 12, 14-17, 20, 23, 27 and 30-52 is/are rejected.
- 7) ☒ Claim(s) 4, 9, 13, 18, 21, 24-26, 28 and 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Response to Arguments**

1. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 31-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 31-52 recites "recording the image formation information in the same optical disk by using the optical writing process after the visual image is formed on the surface of the optical disk" which could not find any where in the specification described in such a way as to enable one skilled in the art to which it pertains. (see [0039] after the visual image formation information is duplicated to a duplication destination optical disk, the visual image is formed on the duplication destination optical disk based on the visual image formation information, which is opposite what are claimed in claims 31-52).

Hence there would be undue experimentation for one of skill in the art to make and use the invention.

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2-3, 11-12, 20, 23, 27 and 30-32, 39-41, 48-49 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Taira et al. (US 5,809,003).

Regarding claim 2, Taira discloses a method of forming a visual image having a specified shape on a surface of an optical disk by using an optical writing process of irradiating a laser beam onto the surface of the optical disk to form pits, the optical disk having a program area along the surface of the optical disk for recording information and being capable of recording information in the program area by the optical writing process (see abstract), the method comprising the steps of:

acquiring image formation information associated to a visual image to be formed (see Figs. 2, 5);

forming the visual image in the program area of the optical disk based on the acquired image formation information by using the optical writing process (see Figs. 2-5, abstract, cols. 1-2); and

recording the image formation information in the program area of the same optical disk by using the optical writing process (see Figs. 2-5 and cols. 1-2).

Regarding claim 3, discloses the method according to claim 2, further comprising the step of placing the optical disk in a recording end state after the image formation information is recorded so that the disk is made unable to additionally record information anymore (inherently).

Regarding claims 11, 20 and 23, 31, 39, 40, 48, 49, 51 see rejection above of claim 2.

Regarding claims 12, 32, 41, see rejection above of claim 3.

Regarding claim 27, discloses the method of claim 2, wherein the recording step records the image formation information which represents a pattern of irradiating the laser beam on the basis of a polar coordinates system defined on the surface of the optical disk (see Fig. 5).

Regarding claim 30, see rejection above of claim 27.

### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5-8, 14-17, 34-37, 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taira et al. (US 5,809,003) in view of Onodera et al. (US 2001/0040867).

Regarding claim 5, Taira discloses the method according to claim 2, wherein the step of recording records the image formation information containing start address information specifying a position of the surface of the optical disk to start the optical writing process for forming the visual image, stop address information specifying another position to stop the optical

writing process for forming the visual image, and pattern information specifying a pattern of irradiating the laser beam during the optical writing process for forming the visual image (inherently). However, to be more specific, Onodera discloses the step of recording records the image formation information containing start address information specifying a position of the surface of the optical disk to start the optical writing process for forming the visual image, stop address information specifying another position to stop the optical writing process for forming the visual image, and pattern information specifying a pattern of irradiating the laser beam during the optical writing process for forming the visual image (see Fig. 11).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide writing address in Taira, as suggested by Onodera, the motivation being in order to record the image formation information containing start address information specifying a position of the surface of the optical disk (see Onodera).

Regarding claim 6, see Fig. 5, discloses the method according to claim 2, wherein the step of recording records the image formation information containing image data which represents the visual image and which is recorded in a format readily readable from the optical disk for reproduction of the visual image.

Onodera discloses the image formation information containing image data which represents the visual image and which is recorded in a format readily readable from the optical disk for reproduction of the visual image on a display (see Fig. 3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a display unit in Taira, as suggested by Onodera, the motivation

being in order to read a message for prompting an instruction about whether pit art recording of this bit map data can be started (see Onodera col. 5).

Regarding claims 7-8, or 34-35, or 36-37, 43-46, see rejection above of claims 5-6.

Regarding claim 14, see rejection above of claim 5.

Regarding claims 16-17, see rejection above of claim 7-8, respectively.

Regarding claim 15, see rejection above of claim 6.

#### **Allowable Subject Matter**

8. Claims 4, 9, 13, 18, 21 and 24-26, 28-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the cited references disclose or suggest all the limitations in parent claim including limitation placing the optical disk in a recording end state on the surface of the optical disk so that the optical disk is made unable to additionally. However, Onodera does not disclose the step of placing the optical disk in a recording end state while leaving a reserved area on the surface of the optical disk so that the optical disk is made unable to additionally record information except for the reserved area, wherein the step of recording records the image formation information in the reserved area after the optical disk is placed in the recording end state or placing the optical disk in a recording end state while an available area is left in the program area of the optical disk, so that the optical disk is made unable to additionally record information on the available area anymore, wherein the visual image is formed in the available area of the optical disk by using the optical writing process, and the image formation information is recorded in the same available area of the program area by using the optical writing process.

None of the cited references disclose or suggest all the limitations in parent claim including limitation copying the image formation information recorded in the origin optical disk to the duplicate optical disk by using the optical writing process; and reproducing the visual image on the surface of the duplicate optical disk by using the optical writing process based on the copied image formation information.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### **Claim Cited References**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references relate to an optical disk and a reproduction method reproduction apparatus, and recording apparatus for the same and information reproducing method judging a



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multivalued level of a present call by referring to judged multi-valued levels of a preceding cell and a ensuing cell.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN T. PHAM whose telephone number is 571-272-7590. The examiner can normally be reached on Monday-Thursday from 9:00am – 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP



WAYNE YOUNG  
SUPERVISORY PATENT EXAMINER